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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/755,529	01/12/2004	Peter J. Wilk	W07-514	1300

7590 10/21/2004
R. Neil Sudol
714 Colorado Avenue
Bridgeport, CT 06605-1601

EXAMINER

AHMED, SAMIR ANWAR

ART UNIT PAPER NUMBER

2623

DATE MAILED: 10/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/755,529

Applicant(s)

WILK, PETER J.

Examiner

Samir A. Ahmed

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/12/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 12-17 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12 recites the limitation "placing of said flexible surface in contact with" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 13 recites the limitation "placing of said flexible surface in contact with" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

Claim 14 recites the limitation "placing of said flexible surface in contact with" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 16 recites the limitation "placing of said flexible surface in contact with" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

Claim 17 recites the limitation "placing of said flexible surface in contact with" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

Claim 28 recites the limitation "said bag" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Obviousness Type Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

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1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-28 of U.S. Patent No. 6,678,403 to Wilk.

Claim 1 of the instant application recites the same features of claim 1 of U.S. Patent No. 6,678,403, "an engagement surface" in claim 1 is obvious in view of "a flexible surface" recited in claim 1 of the Patent, because the flexible surface as enabled by the original specification is the surface that engages the solid structural member, "placing said engagement surface in contact with a solid structure" in claim 1 is obvious in view of "conforming said flexible surface to a solid structure" recited in claim 1 of the Patent, because the flexible surface as enabled by the original specification is the surface that engages the solid structural.

Claims 2-9 of the instant application recite the same features of claims 2-9 of U.S. Patent No. 6,678,403.

Claims 10-11 of the instant application recite the same features of claims 10-11 of U.S. Patent No. 6,678,403, "said engagement surface being a surface of said web" in claim 10 is obvious in view of "said flexible surface being a surface of said web" recited in claim 10 of the Patent, because the flexible surface as enabled by the original

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specification is the surface that engages the solid structural member, i.e., the flexible surface is an engagement surface, and "the placing of said engagement surface in contact with said structural member" in claim 11 is obvious in view of the conforming of said flexible surface to said structural member" in claim 11 of the Patent, because the flexible surface as enabled by the original specification is the surface that engages the solid structural member.

Claims 12-21 of the instant application recite the same features of claims 12-21 of U.S. Patent No. 6,678,403.

Claim 22 of the instant application recite the same features of claim 22 of U.S. Patent No. 6,678,403; "an engagement surface" in claim 22 is obvious in view of "a flexible surface " recited in claim 22 of the Patent, because the flexible surface as enabled by the original specification is the surface that engages the solid structural member.

Claims 23-28 of the instant application recite the same features of claims 23-28 of U.S. Patent No. 6,678,403.

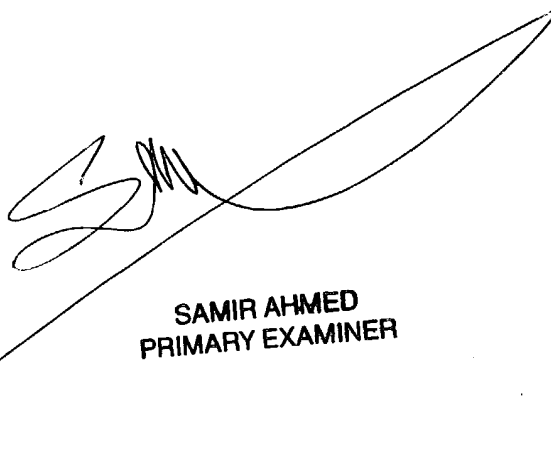
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samir A. Ahmed whose telephone number is 703-305-9870. The examiner can normally be reached on Mon-Fri 8:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au can be reached on 703-308-6604. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SA



**SAMIR AHMED
PRIMARY EXAMINER**